



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Martin Kelly Jones

Serial No.: 08/852,119

Filed: May 6, 1997

For **ADVANCE NOTIFICATION SYSTEM
AND METHOD UTILIZING A
COMPUTER NETWORK**

Examiner: Louis-Jacques, J.

Art Unit: 3661

Docket No: 050711-1026

#311 Reply Brief 12/14/99

REPLY BRIEF UNDER 37 C.F.R. §1.193

Assistant Commissioner for Patents
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Sir:

This Reply Brief under 37 C.F.R. §1.193 is submitted in response to the Examiner's

Answer mailed on October 29, 1999.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper.

However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Deposit

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REMARKS

Applicant respectfully traverses all of the rejections described in the Examiner's Answer for at least the reasons set forth in the Appeal Brief filed on September 23, 1999.

Response to Examiner's Arguments

In responding to Applicant's arguments, it is asserted in the Examiner's Answer that:

In arguing the rejections, appellant contended that "[T]he fact that an application named a different inventive entity than a patent does not constitute necessarily make that patent prior art.", citing Applied Materials Inc. v. Gemini Research Corp.

The examiner agrees. *However, if the patent has an earlier US effective filing date than the application, such a patent is considered to be prior art.* In the present case, the present application as filing date of May 6, 1997, while the prior art references have an effective US filing date of May 14, 1993.

Appellant continued by stating that, citing In re DeBaun, "[A]n applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application."

The examiner agrees. *However, this only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity.* In the present case, the application names only Martin Kelly Jones, while the applied patents name only John Ross. (Pages 6-7, footnotes omitted).

Applicant respectfully traverses the foregoing conclusions by the Patent Office. As described on page 9 of the Appeal Brief, the case of *In re Mathews* sets forth facts in which a patent with an earlier filing date than a patent application was removed as a prior art reference under 37 C.F.R. §1.132, even though the patent and the patent application named different inventive entities.

It is further asserted in the Examiner's Answer that:

Appellant further asserted that "[a]n applicant may overcome a rejection based on a patent 'by showing that the patent disclosure is a description of applicant's own previous ...'", citing M.P.E.P. §2136.05 and In re Mathews.

The examiner agrees. *However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee.* (Page 7, footnotes omitted).

Applicant respectfully traverses the foregoing conclusions by the Patent Office. Applicant has carefully reviewed case law, statutory law, and the M.P.E.P. and can find no basis for refusing to remove a prior art reference for the aforementioned reasons set forth in the Examiner's Answer *when it can be shown that the inventor of the prior art reference derived the relevant subject matter from the Applicant.*

Furthermore, Applicant submits that in requiring the Applicant to show either of the two foregoing cases (*i.e.*, to show that Applicant is a named inventor in the Ross patents or that the present application and the Ross patents are assigned to the same assignee) before removing the Ross patents as prior art under 37 C.F.R. §1.132, the Patent Office is incorrectly focusing on the "by another" requirement of 35 U.S.C. §102(e). As set forth on page 10 of the Appeal Brief, the focus in the present case should be on the "before the invention" requirement of 35 U.S.C. §102(e). In this regard, if it can be shown that Ross derived the relevant subject matter from the Applicant, then Ross is not the inventor of the relevant subject matter, and the filing date of any Ross patent that includes the relevant subject matter is necessarily after the date that Applicant invented the relevant subject matter. Whether or not the present application and the Ross patents have the same named inventorship or are assigned to the same entity does not affect whether the Applicant invented the relevant subject matter before the filing dates of the Ross patents. Therefore, whether or not the present application and the Ross patents have the same named inventorship or are assigned to the same entity is not a proper subject of inquiry in determining whether or not the Ross patents should be removed under 37 C.F.R. §1.132 in the present case.

It is further asserted in the Examiner's Answer that:

Appellant attempted to show the similarities between the present application and the case in In re Mathews. However, one major difference between the present applicant and the In re Mathews' case is that Dewey and Mathews were co-workers. In the present case, there is no showing (other than applicant's statement) that applicant and Ross were co-workers. In fact, let it be known that the US patents to Ross, which named only one inventor, Mr. John Ross, are assigned to Worldwide Notification Systems, Inc. and the present application, which names only one inventor, Mr. Martin Kelly Jones, is assigned to Global Research Systems, Inc. (Pages 7-8).

Applicant respectfully traverses the conclusion that the Applicant must show that he and Ross were co-workers to remove the Ross patents as prior art under 37 C.F.R. §1.132.

In this regard, to remove a prior art reference under 37 C.F.R. §1.132 in the absence of a time bar, it is only necessary to show that the named inventor of the prior patent derived his knowledge of the relevant subject matter from the applicant. The applicant and prior inventor being co-workers is only one scenario in which this may happen, and *Mathews* should not be interpreted as requiring evidence showing that the applicant was a co-worker of the named inventor of the prior patent. In fact, it is asserted in M.P.E.P. §2136.05 that:

when the unclaimed subject matter of a patent is applicant's own invention, applicant may overcome a *prima facie* case based on the patent by showing that the patent disclosure is a description of applicant's own previous work. Such a showing can be made by proving that the patentee was associated with applicant (*e.g.* worked for the same company) and learned of applicant's invention from applicant. (Emphasis added).

Therefore, it is recognized by the M.P.E.P. that the applicant being a co-worker of the named inventor is only an *example* of a scenario in which the named inventor may be "associated" with an applicant so that the named inventor may derive subject matter from the applicant. Accordingly, Applicant respectfully asserts that there are other scenarios in which the named inventor may derive subject matter from the applicant, and it is not necessary for the Applicant to submit evidence

showing that the Applicant and Ross were co-workers to remove the Ross patents as prior art references pursuant to *In re Mathews*.

In addition, even though Applicant traverses the foregoing "co-worker" requirement, Applicant submits that the "co-worker" requirement is satisfied by the facts of the present case. In this regard, Exhibits A - F submitted along with the Third Response filed on June 9, 1999, show that Applicant and Ross were attempting to form a business together and that Ross was responsible for raising money for the business. Therefore, Applicant submits that he and Ross were, in fact, "co-workers."

It is further asserted in the Examiner's Answer that the facts of the present case do not correspond to a scenario described by various M.P.E.P. sections (*e.g.* M.P.E.P. §715.01(a), 715.01(c), and 716.10). See pages 9-14 of the Examiner's Answer. However, Applicant submits that the foregoing sections of the M.P.E.P. set forth situations when an applicant *may* overcome a prior patent or publication. There is no requirement that the facts of any particular case must meet one of the scenarios set forth by the aforementioned sections of the M.P.E.P. in order to overcome a reference via a 37 C.F.R. §1.132 affidavit/declaration. Moreover, in the Appeal Brief, Applicant has established that the requirements of M.P.E.P. §2136.05, *In re Mathews*, and *In re Land* have been satisfied for the facts of the present case and that the Ross patents, therefore, should not be used as prior art references under 35 U.S.C. §102(e).

CONCLUSION

Applicant respectfully requests the Board of Appeals to reverse the Examiner's rejections of all pending claims 1-21 and 23-49 for the reasons indicated.

Respectfully submitted ,

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